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MARCH 1, 00

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Cataldo

Cancellation No. 25,094

Viacom International Inc.

v.

Raymond Robinson

Before Quinn, Chapman, and Wendel,  
Administrative Trademark Judges.

By the Board:

Viacom International Inc. ("petitioner") seeks to cancel the registration of Raymond Robinson ("respondent") for the mark FREE YOUR MIND for "clothing; namely, hats and T-shirts."<sup>1</sup> As grounds for the petition to cancel, petitioner asserts, in pertinent part of its amended petition for cancellation,<sup>2</sup> that since January of 1993 petitioner, through its division MTV Networks, has used FREE YOUR MIND to describe its public service campaigns to promote awareness among young adults of the value of

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<sup>1</sup> Registration No 1,903,626, issued on July 4, 1995, and reciting June 4, 1994 as the date of first use and date of first use in commerce on the goods.

<sup>2</sup> Petitioner's motion to amend its petition for cancellation was granted as conceded on January 14, 1997.

cultural diversity; that petitioner's public service announcements relating thereto prominently display its FREE YOUR MIND mark; that in 1993 petitioner aired two full length television programs under the FREE YOUR MIND mark concerning cultural diversity and tolerance issues; that petitioner has distributed to the public printed material, T-shirts, posters, buttons and stationery bearing the FREE YOUR MIND MARK to promote its public service campaign; that petitioner's broadcast of its FREE YOUR MIND public service announcements and programs, and distribution of its promotional materials, predates respondent's first use of the mark; that the public has come to recognize the mark FREE YOUR MIND as identifying petitioner's services and products; that respondent's Registration No. 1,903,626 is blocking registration of petitioner's application Serial No. 74/581,973<sup>3</sup> for the mark FREE YOUR MIND for T-shirts and hats; and that respondent's mark, when used on its identical goods, so resembles petitioner's mark, as to be likely to cause confusion, mistake or deception.

Respondent, in its answer, denies the salient allegations of the petition to cancel, and also raises the affirmative defense that petitioner lacks standing to bring this action.

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<sup>3</sup> Action on this application has been suspended pending the outcome of the instant cancellation proceeding.

This case now comes before the Board for consideration of petitioner's motion for summary judgment on the ground of priority and likelihood of confusion under Trademark Act Section 2(d). The motion is fully briefed.<sup>4</sup>

In support of its motion for summary judgment, petitioner essentially argues that the mark FREE YOUR MIND in the registration at issue is identical to the mark in petitioner's Registration No. 2,034,019<sup>5</sup> for "educational services, namely providing a continuing series of television announcements and short television programs featuring social, cultural and current event issues" and "promoting public awareness of social, cultural and current event issues"; that petitioner made use of its mark prior to the earliest date upon which respondent may rely for purposes of priority of use; that petitioner's mark FREE YOUR MIND is famous and, accordingly, is entitled to a broad scope of

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<sup>4</sup> Petitioner's motion for leave to file a reply brief is granted. Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a). In this case, we have considered petitioner's reply brief because it clarifies the issues.

<sup>5</sup> Registration No. 2,034,019, issued on January 28, 1997, and reciting February, 1993 as the date of first use and date of first use in commerce for both classes of services.

We note that a party in a Board proceeding may make its pleaded registration of record, for purposes of summary judgment only, by filing, as petitioner has done, a status and title copy thereof with its brief on the summary judgment motion. See *Bongrain International (American) Corp. v. Moquet Ltd.*, 230 USPQ 626 (TTAB 1986). Cf. 37 CFR §2.122(d)(2). The evidence submitted for summary judgment is not otherwise of record. See TBMP § 528.05(a).

protection; that it is a common industry practice for public service slogans to appear on ancillary products including clothing products; that petitioner has made prior use of the mark FREE YOUR MIND on T-shirts distributed to the public through cable affiliates to promote its services; that the parties are thus using identical marks to identify goods that are identical in part; that the goods and services at issue herein are available in the same channels of trade to the same classes of purchasers; and that respondent may have been aware of petitioner's prior use of its mark.

Petitioner has submitted the affidavits of Linda Abrams, Director of Affiliate Marketing for its MTV Network division; Christina Norman, Senior Vice President of On Air Promotions for its MTV Network division; Jeanne Cassidy, Director of Media Services for its MTV Network division; Robin Silverman, petitioner's Assistant Secretary; and Eric W. McCormick, one of its attorneys. In addition, petitioner has submitted respondent's initial and supplemental responses to petitioner's first set of interrogatories and document requests; respondent's responses to petitioner's second request for admissions; portions of the discovery deposition of respondent; computer printouts of news articles relating to petitioner's FREE YOUR MIND public service campaign; communications between the attorneys for the parties; an unpublished Board decision; status and title

copies of petitioner's pleaded registration as well as an additional registration owned by petitioner for a different mark; an "affiliate kit" distributed to petitioner's cable affiliates regarding petitioner's services and goods offered under the FREE YOUR MIND mark; an order form for FREE YOUR MIND T-shirts dated September 29, 1993; marketing memoranda and a letter from the publisher of SPIN magazine regarding petitioner's FREE YOUR MIND public service campaign; an entry form for petitioner's FREE YOUR MIND commercial contest; a printed program from petitioner's 1993 MTV Video Music Awards Show featuring themed advertisements relating to its FREE YOUR MIND public service campaign; printed documents describing its FREE YOUR MIND college radio programs; videotaped copies of its FREE YOUR MIND public service announcements; printed copies of press releases regarding its FREE YOUR MIND public service campaign; and a letter from a third party promising to cease and desist using FREE YOUR MIND on T-shirts based on petitioner's registration thereof.<sup>6</sup>

Petitioner also submitted the parties' stipulation to the following facts: (1) that respondent makes no claim that his mark FREE YOUR MIND is strong or has acquired secondary meaning; and (2) that November 9, 1993, the filing date of

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<sup>6</sup> We note that petitioner has enclosed copies of the pleadings in this cancellation proceeding in support of its motion for summary

the registration at issue herein, is the earliest date upon which respondent is entitled to rely for purposes of priority and that respondent will not assert any prior date as his actual or constructive first use date of the mark FREE YOUR MIND.

In response to the motion for summary judgment, respondent essentially maintains that there are disputed material facts relative to his good faith and lack of intent to trade on the good will of petitioner; the fame of petitioner's mark and the scope of protection accorded thereto; whether use of FREE YOUR MIND by third parties has diluted or reduced the scope of protection of petitioner's mark; and whether petitioner's use of FREE YOUR MIND on clothing is a bona fide and protectable use of the term as a mark, which preclude the granting of summary judgment. Moreover, respondent argues that he first conceived of the FREE YOUR MIND line of clothing in 1991; that he had no prior knowledge of petitioner's mark; that petitioner did not file an application for registration of its mark until October 4, 1994; that the results of a trademark search performed at respondent's request indicated that FREE YOUR MIND was available for use as a mark; that the music industry has made use of FREE YOUR MIND as a song title and

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judgment. The pleadings are already part of the record, and should not be attached as exhibits to filings.

lyric prior to that of either petitioner or respondent; and that petitioner does not currently promote its FREE YOUR

MIND mark.<sup>7</sup>

In support of his position, respondent has submitted his own declaration, as well as those of Michael McCaffrey, a graphic artist who assisted respondent in designing his FREE YOUR MIND logo and produced respondent's hang tags bearing the FREE YOUR MIND mark; and of James Hellwege, his attorney. In addition, respondent has submitted petitioner's responses to several of respondent's interrogatories; an invoice for production of respondent's hang tag design featuring the FREE YOUR MIND mark; copies of lyric sheets from musical groups using the wording FREE YOUR MIND in song lyrics; and a copy of a printed promotional

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<sup>7</sup> Respondent's argument that petitioner's motion for summary judgment must be denied because the Board "misapplied" the excusable neglect standard in its determination of respondent's motion for additional discovery under Fed. R. Civ. P. 56(f) is not well taken. To the extent that respondent's argument can be viewed as a request for reconsideration of the Board's decision on its 56(f) motion, it is denied as untimely. See Trademark Rule 2.127(b). Furthermore, we note that petitioner filed its motion for summary judgment after the close of discovery on issues presented in its petition for cancellation. Respondent was thus afforded a full opportunity to conduct discovery on these matters during the discovery period, and failed in its 56(f) motion to establish the need for additional discovery in order to respond to the summary judgment motion. Inasmuch as permitting respondent additional discovery on these matters would require reopening the discovery period, the Board correctly applied the excusable neglect standard in its determination of respondent's 56(f) motion. See Fed. R. Civ. P. 6(b).

article concerning a musical group using the wording FREE YOUR MIND as an album title.

In reply, petitioner essentially argues that its use of the service mark FREE YOUR MIND on promotional T-shirts is bona fide trademark use; that between January and October of 1993 alone, petitioner received orders from cable affiliates for nine hundred T-shirts; that it is making continuous use of its FREE YOUR MIND mark; and that respondent's allegations of third-party use do not demonstrate third-party use of FREE YOUR MIND as a mark, but merely as a song lyric and title.

With its reply brief, petitioner submitted the declaration of Rose Auslander, one of its attorneys; additional portions of the discovery deposition of respondent; examples of logos used by respondent featuring FREE YOUR MIND; portions of respondent's answers to petitioner's first set of interrogatories; a copy of the results of a trademark search of the words FREE YOUR MIND conducted on behalf of respondent; and petitioner's responses to respondent's second set of interrogatories.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has



the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA*, *supra*.

After a careful review of the record in this case, we find that there are no genuine issues of material fact and that petitioner is entitled to judgment as a matter of law.<sup>8</sup>

Turning first to the question of priority, we note that the parties to this proceeding have stipulated that November 9, 1993 is the earliest date upon which respondent is

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<sup>8</sup> As a preliminary matter, we note that there is no genuine issue as to petitioner's standing. Petitioner attached to its motion for summary judgment a status and title copy of its non-pleaded Registration No. 2,034,019 for the mark FREE YOUR MIND (child application of Serial No. 74/581,973). Moreover, there is of record evidence of petitioner's use of the mark FREE YOUR MIND in

entitled to rely for purposes of priority. (Exhibit 12 to petitioner's main brief on motion for summary judgment.) In addition, petitioner has submitted evidence by affidavit that it instituted its FREE YOUR MIND campaign, including the distribution of promotional T-shirts, in January, 1993 and that petitioner distributed over nine hundred T-shirts bearing the FREE YOUR MIND mark between January and October, 1993. (Affidavit of Linda Abrams.) Moreover, petitioner has submitted a copy of a request for the printing of one thousand FREE YOUR MIND T-shirts dated September 29, 1993. A notation thereon requests the "same design as previous print job". (Exhibit 18.) The above-referenced affidavit indicates that this printing request was in addition to a previous printing to fulfill T-shirt orders placed by petitioner's affiliates. (Abrams affidavit, *supra*.) See Fed. R. Civ. P. 56(e). See also Fed. R. Civ. P. 56(c); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); and *C & G Corp. v. Baron Homes, Inc.*, 183 USPQ 60 (TTAB 1974). In view thereof, we find no genuine issue as to petitioner's priority of use of the mark FREE YOUR MIND.

Turning to the question of likelihood of confusion, we find that there is no genuine issue of material fact for trial. The goods identified by the mark in respondent's

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connection with goods and services. See 15 U.S.C. § 1064. See

Registration No. 1,903,626 are "clothing, namely, hats and T-shirts". Petitioner has introduced evidence that it distributes goods, including T-shirts, under a virtually identical mark to that of respondent to promote its educational and public awareness services. Accordingly, respondent's unsupported assertion that petitioner has not made bona fide use of FREE YOUR MIND as a mark on clothing is not well taken. See Fed. R. Civ. P. 56(e). See also *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991), and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Therefore, it is not necessary for us to consider the relatedness of petitioner's services and respondent's goods herein, inasmuch as petitioner's goods are included among the goods identified in the registration at issue.

In view thereof, respondent's assertions regarding his good faith and lack of intent to trade on petitioner's goodwill, the lack of fame of petitioner's mark and the scope of protection afforded thereto, and use of FREE YOUR MIND by third parties, are unpersuasive given the lack of a genuine issue as to (1) petitioner's priority and (2) that the parties are using identical marks to identify goods that are, in part, identical.

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also TBMP § 303.

In sum, respondent has failed to disclose any evidence that points to the existence of a genuine issue of material fact on the issue of likelihood of confusion.

We find that there are no genuine issues of material fact and that petitioner is entitled to judgment as a matter of law. In view thereof, petitioner's motion for summary judgment is granted, judgment is entered against respondent, and Registration No. 1,903,626 will be cancelled in due course.

T. J. Quinn

B. A. Chapman

H. R. Wendel  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board